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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/180,269 07/08/99 BALL

K CCI-007US

AMY E. MANDRAGOURAS
LAHIVE & COCKFIELD, LLP
28 STATE STREET
BOSTON MA 02109

HM22/1023

EXAMINER

MURPHY, J

ART UNIT	PAPER NUMBER
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1646

DATE MAILED:

10/23/01

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Applicant No.	Applicant(s)	
	09/180,269	BALL ET AL.	
	Examiner	Art Unit	
	Joseph F Murphy	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 August 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-12,17 and 31-50 is/are pending in the application.
- 4a) Of the above claim(s) 3-5,7,9,31-43 and 48-50 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2,6,8,10-12,17 and 44-47 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>13</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Formal Matters

Claims 2-7, 9, 10, 12, 17 and 38-40 were amended, and new claims 44-50 were added, in Paper No. 15, 8/10/2001.

Newly submitted claims 42-43 and 48-50 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are drawn to a method distinct from the elected method for reasons of record set forth in Paper No. 8, 8/18/2001 and Paper No. 12, 3/8/2001.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 42-43 and 48-50 are withdrawn from consideration as being directed to a non-elected invention. Claims 3-5, 7, 9, 31-41 stand withdrawn from consideration pursuant to 37 CFR 1.142(b); also see MPEP § 821.03.

Claims 2, 6, 8, 10-12, 17, 44-47 are under consideration.

Response to Amendment

Applicant's arguments filed in Paper No. 15, 8/10/2001 have been fully considered but they are persuasive in part.

The objection to claim 9 has been obviated by Applicant's amendment, and is thus withdrawn.

The rejection of claims 2, 6, 8, 10-12 and 17 under 35 U.S.C. 112, second paragraph has been obviated by Applicant's amendment, and is thus withdrawn.

Claim Rejections - 35 USC § 103

Claims 2, 6, 8, 10-12 and 17 stand rejected, and new claims 44-47 are rejected, under 35 U.S.C. 103(a) as being unpatentable over WO 94/09135 (Beach et al.) in view of Xiong et al. (1993).

As set forth in the previous Office Action, Beach discloses a method of screening compounds for their ability to inhibit or suppress the transformation of a cell, which may include prevention of formation of complexes including cyclin D, p21 and CDK (page 24, line 12 to page 25, line 9). The Xiong et al. reference is cited to exemplify that the sequence of p21 comprises the claimed KRRLIFSK sequence.

Applicant argues that Beach does not teach the specific regions disclosed in the instant application, and that Xiong does not remedy the deficiencies of the Beach reference. However, Beach discloses that drugs which alter p21 function can be used to inhibit or enhance cell division (page 25, lines 22-23), and that these drugs can be small peptides which mimic the complex constituent in terms of binding but which lacks its active regions (page 25, lines 25-26). Therefore, the Beach reference teaches that peptides derived from p21 can be used to inhibit cyclin D1 complex formation, and Beach also discloses methods of identifying such peptides. In the claims of the instant application, the first substance is a peptide fragment of p21 which comprises SEQ ID NO: 23. This encompasses any peptide that contains SEQ ID NO: 23, and any other amino acids sequences. Thus, a claim in which the first substance is a peptide fragment consisting of SEQ ID NO: 23 is free of the art, and the instant claims are not patentable because of the open language in the claims.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.
Patent Examiner
Art Unit 1646
October 17, 2001

Prema Mertz
PREMA MERTZ
PRIMARY EXAMINER